



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/822,010	04/09/2004	Thienna Ho	859820-2	1679
7590 12/01/2005 O'MELVENY & MYERS LLP 400 SOUTH HOPE STREET LOS ANGELES, CA 90071-2899			EXAMINER YU, GINA C	
			ART UNIT 1617	PAPER NUMBER
DATE MAILED: 12/01/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/822,010	Applicant(s) HO, THIENNA	
	Examiner Gina C. Yu	Art Unit 1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>4/9/04, 9/19/05</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 5, 8, and 10 recite the term “approximately” in defining the weight amount of methyl sulfonyl methane (“MSM”). Applicants do not define what range is covered by the term “approximately”. The metes and bounds of the scope of this limitation are uncertain particularly in this case because a prior art discloses a composition comprising MSM in an amount that is close to 1. See Scott (US 6183758 B1) (example comprises 0.7 % of MSM).

The remaining claims are rejected as depending on indefinite base claims.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 5, and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Herschler (US 4296130).

Claim 1 is directed to a composition suitable for direct application to the face and body of a user, comprising methyl sulfonyl methane ("MSM") and a vehicle, wherein approximately 1-20 % by weight of MSM is dissolved in the vehicle.

Herschler discloses an aqueous solution comprising 10 % by weight of MSM. See 1; instant claims 1 and 2. The reference also teaches in col. 2, lines 18 – 68 that MSM is a naturally occurring substance, and beautifies the complexion of the skin when applied topically. The reference teaches that the composition can be in solution, cream, lotion or gel for topical administration, depending on its intended use. See col. 2, lines 41 – 46. See instant claim 5.

The phrase "for lightening the natural skin color of the user and for treating disorders of hyperpigmentation" in claim 1 is not afforded patentable weight as it is directed to a preamble which recites the intended future use of the composition. See MPEP § 2111.02.

It is noted that the reference is silent as to the skin lightening property of MSM compound and the composition comprising thereof. However, since the prior art teaches the same compound, the recited property of the MSM is necessarily present in the prior art. Also, since a chemical composition and its properties are inseparable, the prior art composition also has the same skin lightening property. See In re Spada, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990).

Claim 10 recites a method for lightening the natural skin color of a user and for treating disorders of hyperpigmentation, comprising directly applying the composition to the face and body of the user. When a claim recites using an old composition or

structure and the "use" is directed to a result or property of that composition or structure, then the claim is anticipated. See In re May, 574 F.2d 1082, 1090, 197 USPQ 601, 607 (CCPA 1978). In this case, Herschler anticipates claim 10 since the claimed use of the prior art composition to lighten the skin is directed to the result and property of the composition.

Claims 1, 2, 4, 5, 7, and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Kuhnau (US 2002/0142019 A1).

Kuhnau discloses a cosmetic composition comprising 5 % by weight of MSM and vitamin C (ascorbyl palmitate) and vitamin E. See [0046], Example 1; instant claims 1, 4, and 7. The reference teaches that the composition is made in the form of lotion, creams, oils, and gels. See [0034] and [0039]. See instant claims 2 and 5.

The phrase "for lightening the natural skin color of the user and for treating disorders of hyperpigmentation" is a preamble which recites the intended use or purpose of the composition, and does not define the structural limitation of the composition. Thus, no patentable weight is given to this phrase.

It is noted that the reference is silent as to the natural occurrence of MSM and the skin lightening property of the compound and the composition comprising thereof. However, since the prior art teaches the same compound, the recited properties of the MSM is necessarily present in the prior art. Also, since a chemical composition and its properties are inseparable, the prior art composition also has the same skin lightening property. See In re Spada.

Kuhnau teaches topically applying the same composition that is used by applicants. See [0009]-[0010]. When a claim recites using an old composition or structure and the "use" is directed to a result or property of that composition or structure, then the claim is anticipated. See In re May. Claim 10 is anticipated since the claimed use of the prior art composition to lighten the skin is directed to the result and the property of the composition.

Claims 1, and 5-7, and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Scott (US 6183758 B1).

Scott discloses a skin cream comprising 0.7 % of MSM, which, given the broadest interpretation of the claim limitation, is within the claimed range of "approximately 1-20 weight percent". See Example: instant claims 1 and 5. The composition also comprises vitamin E and fragrance. See instant claims 6, and 7.

The phrase "for lightening the natural skin color of the user and for treating disorders of hyperpigmentation" in claim 1 is not afforded patentable weight since this is a preamble which merely recites the intended use or purpose of the composition.

Scott is silent as to the natural occurrence of MSM and the skin lightening property of the compound and the composition comprising thereof. However, since the prior art teaches the same compound, the recited properties of the MSM is necessarily present in the prior art. Also, since a chemical composition and its properties are inseparable, the prior art composition also has the same skin lightening property. See In re Spada.

Scott teaches topically applying the same composition that is used by applicants. When a claim recites using an old composition or structure and the "use" is directed to a result or property of that composition or structure, then the claim is anticipated. See In re May. In this case, the reference anticipates claim 10 since the claimed use of the prior art composition to lighten the skin is directed to the result and the property of the composition.

Claims 8 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by US Charter et al. (US 6541045 B1) ("Charter").

Charter discloses a tablet comprising 400 mg of MSM and magnesium (a mineral). See comparative example 1; instant claims 8 and 9.

The phrase "for lightening the natural skin color of the user and for treating disorders of hyperpigmentation" is not given patentable weight since this is directed to a preamble, which merely recites the intended use or purpose of the composition.

Charter is silent as to the natural occurrence of MSM and the skin lightening property of the compound and the composition comprising thereof. However, since the prior art teaches the same compound, the recited properties of the MSM are necessarily present in the prior art. Also, since a chemical composition and its properties are inseparable, the prior art composition also has the same skin lightening property. See In re Spada.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3, 4, 6, and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Herschler (US 4296130) as applied to claims 1, 2, 5, and 10 as above, and further in view of Scott (US 6183758 B1).

While Herschler teach making topical solution comprising MSM, the reference fails to teach adding fragrance or nutrients to the composition.

Scott, discussed above, teaches skin cream composition comprising MSM, vitamin E, and fragrance. See instant claims 3, 4, 6, and 7.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the topical solution of Herschler by adding the additives of Scott, such as vitamin E and fragrance, because both references are directed to similar topical compositions comprising MSM, such as cream, lotion, and gel; and 2) latter teaches a cosmetic formula comprising specific cosmetic additives such as antioxidants and fragrance. The skilled artisan would have had a reasonable expectation of successfully producing a cosmetic composition comprising MSM in a solution form with more stability and cosmetic appeal.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

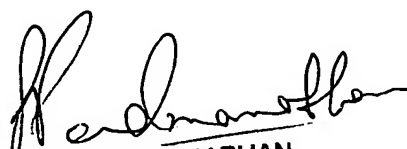
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 571-272-8605.

The examiner can normally be reached on Monday through Friday, from 9:00AM until 6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gina Yu
Patent Examiner



SREENI PADMANABHAN
SUPERVISORY PATENT EXAMINER